

## **REMARKS**

### **I. Introduction**

Claims 1 to 16 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 1 to 5, 7 to 13, 15 and 16 Under 35 U.S.C. § 103(a)**

Claims 1 to 5, 7 to 13, 15 and 16 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of PCT International Published Patent Application No. WO 98/53229 ("Werner et al.") and U.S. Patent No. 6,168,162 ("Reluzco et al."). Applicants respectfully submit that the combination of Werner et al. and Reluzco et al. does not render obvious the present claims for the following reasons.

Claims 1 and 9 relate to a brush seal and recite that the brush seal includes a bristle housing. Claims 1 and 9 recite that the bristle housing is press-fit on a first one of a rotor and a stator against movement in a radial direction relative to the first one of the rotor and the stator. Claims 1 and 9 have been amended herein without prejudice to recite that first and second positioning arrangements are configured to interact with each other in a positive-locking manner to maintain the press-fit against movement in a radial direction. Support for this amendment may be found, for example, at page 9, lines 8 to 9 of the Specification, which states that "[f]or the assembly, the brush seal 1 ... is pushed into a seat on a stator 9." The Specification further states that, only when "the brush seal 1 [is] dismantled for maintenance or repair" is "the brush seal 1 ... removed from its seat in a stator 9" (see page 9, lines 27-30).

Applicants respectfully submit that the combination of Werner et al. and Reluzco et al. does not render obvious claims 1 and 9 for at least the reason that the combination of Werner et al. and Reluzco et al. does not disclose or suggest all of the features of claims 1 and 9. For example, the combination of Werner et al. and Reluzco et al. does not disclose or suggest first and second positioning arrangements that are configured to interact with each other in a positive-locking manner to maintain the press-fit against movement in a radial direction of a bristle housing press-fit on a rotor or a stator. As set forth above, the Specification states at

page 9, lines 8 to 9 that “[f]or the assembly, the brush seal 1 ... is pushed into a seat on a stator 9” and that only when “the brush seal 1 [is] dismantled for maintenance or repair” is “the brush seal 1 ... removed from its seat in a stator 9.” Specification at page 9, lines 27 to 30. The Specification states at page 7, lines 15 to 18, that “[a]s a result [of the first and second positioning arrangements], a lighter-duty press fit at the circumferential surface 5 of the bristle housing 2 with load relief of the components may be used.”

As an initial matter, the Final Office Action admits at page 2 that “Werner [et al.] fails [to disclose] the first and second positioning arrangements to be configured to interact with each other in a positive locking manner providing definite positioning of the bristle housing.” The Final Office Action maintains in paragraph 18 that “the press fit elements ... are shown by Werner [et al.]” Applicant respectfully disagrees. Referring to the English-language translation of Werner et al. submitted herewith, it is stated at page 5 that “[c]rimping lip 7 does not completely embrace outer edge 8 of support plate 4.” As illustrated in Figure 1, this deformation of the beaded lip 7 provides that the outermost edge of beaded lip 7 is spaced apart from a corresponding internal shoulder of the housing 2, thereby enabling the brush seal 1 to move in a radial direction relative to the housing 2. Thus, Werner et al. fail to disclose or suggest a press-fit against movement in a radial direction of a bristle housing, e.g., brush seal 1, press-fit on a rotor or stator, e.g., housing 2.

Furthermore, Reluzco et al. purport to relate to a self-centering brush seal. In order to provide the self-centering feature, Reluzco et al. describe a number of arrangements for permitting the brush seal to maintain concentricity with the axis of the rotary component during radial excursions of the radial component. According to Reluzco et al., radial constraints on the brush seal are removed so that the seal is permitted to “float” in a radial direction and follow radial excursions of a rotating shaft. See, e.g., col. 1, line 66 to col. 2, line 2. The pin and slot arrangement in Figure 7 of Reluzco et al. (which was referred to and relied on in the Final Office Action) operates to permit the brush seal to move radially relative to the housing so as to follow radial excursions of the rotating shaft. Thus, irrespective of whether the bristle housing of Werner et al. is press-fit, the pin and slot arrangement of Reluzco et al., which provides for a radially floating brush seal, is not intended for, nor even capable of, maintaining a press-fit against movement in a radial direction. The Final Office Action maintains in paragraph 18 that “Reluzco is cited only for the teaching

the arrangement that prevent relative rotation of the seal segments [and that] the press fit elements and all other structures are shown by Werner.” Since, as set forth above, Werner et al. fails to disclose or suggest a press-fit against movement in a radial direction of a bristle housing on a rotor or stator, and since the Final Office Action admits that Reluzco et al. are not relied on to disclose or suggest, and indeed do not disclose or suggest, this feature, Applicant respectfully maintain that the combination of Werner et al. and Reluzco et al. does not disclose or suggest all of the features of claims 1 and 9.

To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Since the combination of Werner et al. and Reluzco et al. does not disclose or suggest all of the features of claims 1 and 9, it is respectfully submitted that the combination of Werner et al. and Reluzco et al. does not render unpatentable claims 1 and 9.

Furthermore, any proposed modification of such a floating radial seal to be press-fit against movement in a radial direction, or to maintain a press-fit against movement in a radial direction, would render the floating brush seal described by Reluzco et al. unsatisfactory for its intended purpose and/or change the principle of operation of the floating brush seal described by Reluzco et al. Accordingly, it is respectfully submitted that there is no suggestion or motivation to make the proposed combination, and, consequently, it is respectfully submitted that the combination of Werner et al. and Reluzco et al. does not render unpatentable claims 1 and 9 for this additional reason.

In addition, Applicants respectfully submit that claims 2 to 5, 7, 8, 10 to 13, 15 and 16, which ultimately depend from claim 1, and therefore include all of the features of claim 1, are also not rendered unpatentable by the combination of Werner et al. and Reluzco et al. for at least the same reasons given above in support

of the patentability of claim 1. In re Fine, supra (any dependent claim depending from a non-obvious independent claim is non-obvious).

**III. Rejection of Claims 6, 8 and 9 Under 35 U.S.C. § 103(a)**

Claims 6, 8 and 9 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Werner et al., Reluzco et al. and U.S. Patent No. 6,106,190 ("Nakamura et al."). It is respectfully submitted that the combination of Werner et al., Reluzco et al. and Nakamura et al. does not render unpatentable claim 6, 8 and 9 for at least the following reasons.

Claim 6 relates to a brush seal and recites that the brush seal includes a bristle housing. Claim 6 has been amended herein without prejudice to recite that the first positioning arrangement and the second positioning arrangement are configured to interact with each other in a positive-locking manner to maintain the press-fit against movement in a radial direction. Support for this amendment is set forth above.

As set forth above in connection with claims 1 and 9, the combination of Werner et al. and Reluzco et al. does not disclose or suggest a first positioning arrangement and a second positioning arrangement that are configured to interact with each other in a positive-locking manner to maintain a press-fit against movement in a radial direction of a bristle housing that is press-fit on a rotor or a stator. Claim 8 ultimately depends from -- and thus includes all of the features of -- claim 1, and therefore the combination of Werner et al. and Reluzco et al. does not disclose or suggest this same feature of claim 8. Still further, the combination of Werner et al. and Reluzco et al. also does not disclose or suggest this same feature of claim 6. Applicants respectfully submit that the combination of Werner et al., Reluzco et al. and Nakamura et al. does not render unpatentable claims 6, 8 and 9 because Nakamura et al. are not relied on to disclose or suggest, and do not disclose or suggest, those features of claims 6, 8 and 9 not disclosed or suggested by the combination of Werner et al. and Reluzco et al. For instance, Nakamura et al. are not relied on to disclose or suggest, and do not disclose or suggest, a first positioning arrangement and a second positioning arrangement that are configured to interact with each other in a positive-locking manner to maintain a press-fit against movement in a radial direction of a bristle housing that is press-fit on a rotor or a stator. Rather, Nakamura et al. purport to relate to a marine fender with a structure

for fixing a pad to a fender frame, and do not in any manner disclose, or even suggest, a bristle housing that is press-fit on a first one of a rotor and a stator against movement in a radial direction relative to the first one of the rotor and the stator, and furthermore do not disclose or even suggest a first positioning arrangement and a second positioning arrangement that are configured to interact with each other in a positive-locking manner to maintain a press-fit against movement in a radial direction of a bristle housing that is press-fit on a rotor or a stator.

In view of all of the foregoing, it is respectfully submitted that the combination of Werner et al., Reluzco et al. and Nakamura et al. does not render unpatentable claims 6, 8 and 9. Withdrawal of this rejection is therefore respectfully requested.

#### **IV. Rejection of Claim 14 Under 35 U.S.C. § 103(a)**

Claim 14 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Werner et al., Reluzco et al. and U.S. Patent No. 5,066,025 ("Hanrahan"). It is respectfully submitted that the combination of Werner et al., Reluzco et al. and Hanrahan does not render unpatentable claim 14 for at least the following reasons.

Claim 14 depends from claim 1 and therefore includes all of the features recited in claim 1. As more fully set forth above, the combination of Werner et al. and Reluzco et al. do not disclose, or even suggest, all of the features recited in claim 1, from which claim 14 depends. Hanrahan does not disclose or suggest the features recited in claim 1 not disclosed or suggested by the combination of Werner et al. and Reluzco et al. Accordingly, it is respectfully submitted that the combination of Werner et al., Reluzco et al. and Hanrahan does not render unpatentable claim 14, which depends from claim 1.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**V. Conclusion**

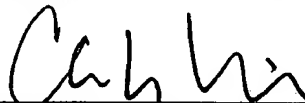
It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Date:

May 30, 2006

By:

Respectfully submitted,



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